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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,845	02/23/2004	Jay S. Walker	03-011	5892

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EXAMINER
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COBURN, CORBETT B

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/784,845

Applicant(s)

WALKER ET AL.

Examiner

Corbett B. Coburn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/23/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of claims 1-26 & 37 in the reply filed on 6 January 2005 is acknowledged.

### ***Specification***

2. In the first line of paragraph 0028, the word "by" should be, "be".

### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the subject matter of claims 6-37 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Applicant's flow chart of Fig 7 is rudimentary to say the least. These drawings do not support the details of the claims. Applicant must illustrate each step of the claimed method.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet"

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pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5 & 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Fey (*Slot Machines, A Pictorial History of the First 100 Years*)

**Claim 1:** On page 94, Fey teaches a Caille 1901 Quintette slot machine. Examiner has chosen this slot machine as representative of its class. Applicant's claims are broad enough to read on virtually every slot machine ever designed. Fey teaches determining a game parameter and a range of values associated with the game parameter (i.e., it has a payable). Fey teaches displaying at least one symbol on a reel where each symbol represents a potential value within the range of values associated with the game parameter. Fey teaches selecting at random at least one of the displayed symbols – i.e., the reels spin and randomly selects which symbols appear on the payline and setting an actual value of the game parameter based on the randomly selected displayed symbol. The payout depends on which symbols appear on the payline.

**Claims 2-4:** Fey teaches initiating, continuing, and ending game play using the actual value of the game parameter. The payable is set throughout the game.

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**Claim 5:** The game parameter could also represent a number of game symbols with which to start a session. The term “game parameter” is so broadly defined in the specification that it could include virtually any aspect of the game that can be chosen randomly. In this case, since the player may randomly choose to bet on between 1 and 5 hands, the number of game symbols with which to start play is chosen randomly.

**Claim 8:** The game parameter could represent a number of reels used in a game. The player randomly chooses between 5 and 20 reels with which to play.

6. Claims 19-26 & 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker et al. (US Patent Number 6,068,552).

**Claim 19:** Walker teaches initiating play of a game at a gaming device; changing a mode of the gaming device from a play mode to a parameter determination mode; receiving a signal from a player to initiate random determination of a game play parameter value; randomly determining a game play parameter value; changing the game based on the game play parameter value; and changing a mode of the gaming device from the parameter determination mode to the play mode. (Figs 9A & B) Since the player may choose any game play parameter value, the game play parameter is determined at random.

**Claim 20:** Receiving the signal from a player includes receiving an indication of at least one type of game play parameter for which to determine a value. The player uses the menu of Fig 3 to indicate which type of parameter to change.

**Claim 21:** Receiving the signal from a player includes receiving an indication of at least one particular game play parameter for which to determine a value. (Figs 4A & B, 5, 6)

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**Claim 22:** Claim 22 is a combination of claims 19 & 20, which see.

**Claim 23:** Walker teaches receiving a request to change the game, and wherein changing the mode of a gaming device from the play mode to the parameter determination mode is done in response to receiving the request to change the game. (Figs 9A & B)

**Claim 24-26:** Walker inherently teaches receiving an indication of a desired number of handle pulls to play the changed game by receiving money from the player. A player has to pay for each game. When the player puts in the money to play the game, this is an indication of a desired number of handle pulls to play the changed game – if the game costs a nickel and the player puts in a quarter, the player indicates that he wants to play five times.

**Claim 37:** Walker teaches receiving an indication of a game play parameter from a player of a gaming device; randomly determining a value for the game play parameter (i.e., the player provides random input of the value); and initiating a pre-paid session of game play (i.e., the player must pay before playing) wherein the gaming device is played using the randomly determined value. (Figs 9A & B)

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 6, 7, 9-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fey as applied to claim 1 above in view of Walker et al. (US Patent Number 6,068,552) and Applicant's disclosure.

**Claims 6, 7, 9-18:** Fey teaches the invention substantially as claimed but does not teach a modern system that is capable of adjusting game parameters on the fly nor does Fey teach the various game parameters claimed. Walker teaches a modern gaming machine that is adapted to change the gaming parameters on the fly. Walker teaches that allowing such changes will induce players to continue playing for extended periods of time. It would have been obvious to one of ordinary skill in the art at the time for the invention to have modified Fey in view of Walker to have a modern slot machine that is capable of changing parameters on demand in order to induce players to continue playing for extended periods of time. Applicant teaches that all of these various game parameters are equivalent. As Walker points out, changing such parameters induce players to continue playing for extended periods of time. It would have been a matter of obvious design choice at the time of the invention to have modified Fey in view of Applicant's disclosure to use these equivalent design elements (i.e., the different claimed game parameters) in order to induce players to continue playing for extended periods of time.

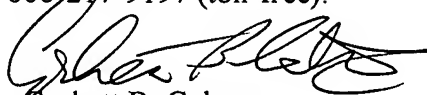
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, Jessica Harrison can be reached on (571) 272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Corbett B. Coburn  
Examiner  
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